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BD-07 appeal

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

In re Application of:

Appeal No. 2004-0677

KI-OOK PARK *et al.*

Original Patent No. 5,917,679 issued on 29 June 1999

Serial No.: 09/892,790

Examiner: TUPPER, ROBERT S.

Filed: 28 June 2001

Art Unit: 2652

For: PSEUDO CONTACT TYPE NEGATIVE PRESSURE AIR BEARING SLIDER

RENEWED REQUEST FOR ORAL HEARING

Paper No. 33

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant requests herewith an Oral Hearing under 37 C.F.R. §1.17(g). The statutory fee incurred by Requesting an Oral Hearing was previously paid on 27 April 2003.

Should other fees be incurred however, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fee.

Respectfully submitted,

Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

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Folio: P56525RE
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Art Unit: 2652

For: PSEUDO CONTACT TYPE NEGATIVE PRESSURE AIR BEARING SLIDER

THIRD REPLY BRIEF

Paper No. 32

Commissioner for Patents
Washington, D.C. 20231

Attn: Board of Patent Appeals & Interferences

Sir:

Pursuant to 37 C.F.R. §41.43 and §41.50, and in response to the Examiner's Paper No. 28 mailed on the 23rd of August 2004, Appellant respectfully requests consideration of this Reply Brief which has been prepared in reply to the remand of this appeal to the Examiner, the *sub-silentio* reopening of the examination by the Examiner, and the withdrawal by the Examiner of the rejection of claims 21 through 60 under 35 U.S.C. §251.

Pursuant to 37 C.F.R. §41.50(a)(2)(ii), Appellant requests "that this appeal be maintained."

This Reply Brief is filed in triplicate (37 C.F.R. §1.192(a)). A written Request for An Oral Hearing before the Board of Patent Appeals and Interferences accompanies this Reply Brief. The statutory fee incurred by that request was previously paid on 28 August 2003.

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BOARD OF PATENT APPEALS
AND INTERFERENCES

I. REAL PARTY IN INTEREST

Pursuant to 37 CFR §1.192(c)(1)(as amended), the real party in interest is:

SamSung Electronics Co., Ltd.
#416, Maetan-dong, Paldal-gu
Suwon-city, Kyungki-do, Republic of KOREA

as evidenced by the Assignment recorded in the United States Patent & Trademark Office on the 6th day of March 1998 at Reel 9030, frame 0967.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals and no interferences known to Appellant, Appellant's legal representatives or the assignee which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 21 through 60 are pending in this application. Claims 1 through 20 have been allowed, and in Appellant's Amendment filed with the Special Program Examiner on Monday, the 18th of October 2004, claims 1 through 20 were canceled.¹ Claims 21, 30 through 32 and 41 stand finally rejected as stated in the final Office Action (Paper No. 9) and in the Examiner's "Office communication" (Paper No. 28). Of the latter claims, claims 21 and 31 are independent, whereas the remaining claims are dependent. Absent any extant objection or rejection, Appellant

¹ Allowed claims 1 through 20 are pending in a continuation application filed on the 9th of December 2002 and assigned Serial No. 10/314,937, and was examined by the same Examiner as the above-captioned application. A Notice of Allowability was counted on the 8th of March 2004, but to date has never been mailed.

understands that claims 22 through 29 and 33 through 40 are allowable; and that claims 42 through 60 are allowed.

IV. STATUS OF AMENDMENTS

Two Amendments were filed after the final Office action (Paper No. 9) mailed on 9 July 2002, amending claims 16, 21, and 31. The first Amendment under 37 CFR §1.116(b) was filed on the 9th of October 2002. In Paper No. 12, an Advisory Action dated on the 16th of October 2002, the Examiner stated that the proposed amendment would not be entered.

A Second Amendment under 37 CFR §1.116(b) was filed on the 27th of November 2002. In Paper No. 15 dated on the 5th of December 2002, the Examiner refused entry of the second amendment.

A Third Amendment under 37 CFR §1.116(b) was filed simultaneously with this Appeal Brief on the 9th of December 2002 to proposed only amendment of claim 16 in one instance. The Examiner's Answer (Paper No. 20) dated on the 27th of February 2003, stated that this "third amendment after final has been entered for this appeal."

A Fourth Amendment under 37 C.F.R. §1.116(b) was filed on the 12th of August 2004 after several discussions with the Special Program Examiner. In Advisory Action (Paper No. 30) dated on the 15th of September 2004, the Examiner wrote that,

"This is an improper amendment. It does not present any present change to the claims. It merely proposes a change based upon some future change in status of another application. The amendment will be noted in the table of contents, but will not be entered."

V. SUMMARY OF CLAIMED SUBJECT MATTER

The *Examiner's Answer* asserted that,

“[t]he summary of invention contained in the brief is deficient because it fails to mention the first and second front projections defining air bearing surfaces (110a) and (110b), and the fourth projection (180) at the rear mounting transducer.”

Both 37 C.F.R. §41.37 and its predecessor rule, 37 C.F.R. §1.192(c)(5) require that the “[t]he brief shall contain ... [a] concise explanation of the invention *defined in the independent claims involved* in the appeal” (Emphasis added). Despite the Examiner’s assertion, Appellant’s *Appeal Brief*“ complies with the requirements of 37 C.F.R. §1.192(c)(5) and §41.37(c)(1)(v) (as amended).

In response to the Examiner’s assertion, Appellant notes that “air bearing surfaces (110a) and (110b),” are illustrated in Figures 4 through 12 and described in column 5, lines 13-25 and column 6, lines 42-52; “and the fourth projection (180) at the rear mounting transducer” is illustrated in Figures 4 through 7 and is described in column 7, lines 32-41.

Turning now to the requirements of 37 C.F.R. §1.192(c)(5) and 37 C.F.R. §41.37(c)(1)(v) that Appellant’s Brief contain a concise explanation of “the invention *defined in the independent claims involved* in the appeal ...” as opposed to all of the several embodiments disclosed in the specification but not defined in the claims involved in the appeal, Appellant directs the attention of the Board to Figs. 4 and 5; the pending claims define Appellant’s negative pressure slider for a hard disk drive with trailing air bearing surface

platforms 110c and 110d symmetrically disposed on opposite sides on a longitudinal axis of the slider body 100 and aligned with one another in a lateral direction of the slider body 100, to provide a positive lifting force at the air outlet between the slider body 100 and the disc surface (not shown).² As is explained in Appellant's patent,

“these trailing ABS platforms 110c and 110d ... provide a positive lifting force at an air outlet between the slider body and the disc surface (not shown).”³

An arcuate cross rail 130 extends across the principal surface 111 of the slider 100 between air bearing surface platforms 110c, 110d.⁴

As explained in the original specification,

“[t]he arcuate cross rail 130 and the rear ABS platforms 110c and 110d together define a substantially U-shaped projection that extends from the principal surface 111 of the slider 110. The curvature of the cross rail 130 forms a negative pressure cavity 150, that may be somewhat rounded at the center of the slider body 110.”⁵

The negative pressure cavity 150 functions to provide a downward pulling action on the slider body 100, which in turn creates a gram load equivalent effect that enhances stability.⁶

Another advantage of the arcuate configuration of the cross rail 130 resides in the fact

² Column 5, lines 25-32.

³ Column 5, lines 27-33.

⁴ Column 5, lines 37-41.

⁵ Column 5, lines 41-46.

⁶ Column 6, lines 4-7.

that contaminates will have less of tendency to accumulate against the front wall of the cross rail.⁷ That is, contaminates such as dust, oil molecules and other impurities, will instead tend to travel along the arcuate front wall and will exit off the side of the slider body between the gaps formed by the front corner ABS projections.⁸ This also enhances read/write performance of the slider 100 over the long-run.⁹

VI. ISSUES

(I). Rejection of Claims 21 Through 60 Under 35 U.S.C. §251

In Paper No. 28, an *Office Communication* mailed on the 23rd of August 2004, the Examiner expressly withdrew “the rejection of claims 21-60 under 35 U.S.C. §251.”

(II). Rejection of Claims 21 through 41 Under Second Paragraph of 35 U.S.C. § 112

The Examiner has implicitly withdrawn all rejections under 35 U.S.C. § 112, in paragraph (6) of the Examiner's Answer.

(III). Rejection of Claims 21 through 60 Under First & Second Paragraphs of 35 U.S.C. §112

The Examiner has implicitly withdrawn all rejections under 35 U.S.C. § 112, in paragraph

⁷ Column 6, lines 19-22.

⁸ Column 6, lines 22-25.

⁹ Column 6, lines 25-26.

(6) of the Examiner's Answer.

(IV). Rejection Of Claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) Over Nepela '981

A. Where The Applied Art Fails To Disclose All Of The Elements Of The Rejected Claims, Can There Be An Anticipation Under 35 U.S.C. §102(a)?

- 1. Nepela '981 Fails To Anticipate Claims 21, 30-32 and 41 Under 35 U.S.C. §102(a).**
- 2. The Final Rejection of Claims 21, 30-32 and 41 Under 35 U.S.C. §102(a) as Anticipated by Nepela '981 Fails to Consider the Entireties of Claims 21, 30-32 and 41.**
- 3. The Rejection of Claims 21, 30-32 and 41 Under 35 U.S.C. §102(a) Depends Upon Misinterpretation of the Language of the Claims to Support an Assertion of Anticipation by Nepela '981.**

B. Modification Of Nepela '981 In A Manner That Would Render Nepela '981 Inoperative, Is Impermissible To Support An Anticipation Rejection Under 35 U.S.C. §102(a).

C. The Examiner's Assertion That *Appellant Sepcifically Identified Several Structural Features Recited In The Claims To Define Over The Prior Art* Rejection Is A *Non Sequitur* That Does Not Support The Rejection Under 35 U.S.C. §102(a).

D. Whether Claims 21 And 31 Do, Or Do Not Preclude The Presence Of Other Air Bearing Surfaces In Addition To The U-Shaped Platform Is Irrelevant To Determinations Of Anticipation Under 35 U.S.C. §102(a).

VII. GROUPING OF THE CLAIMS

Normally, these appeals may be briefed, argued and decided with one or two representative claims. Here, numerous issues are presented in the first Office action and repeated in the final Office action, sometimes with direct application to particular claims while

ignoring others of the rejected claims, and in other instances to several or all of the reissue claims *en mass* without explanation of the application of the rejection to recognition of the distinctions and differentiations existing between the rejected claims. The claims do not therefore, stand or fall together, and thus the claims are grouped and considered individually, for the reasons set forth in the following arguments.

Applicant notes that the several disparate issues raised by the Examiner, in conjunction with the need to address of each independent claim as a representative claim is representative of the extremeness of the Examiner's style of Examination, and is unnecessarily burdensome to the Appellant.

(A). Rejection of Claims 21 Through 60 Under 35 U.S.C. §251

In paragraph (2) of Paper No. 28, an *Office Communication* mailed on the 23rd of August 2004, the Examiner expressly withdrew "the rejection of claims 21-60 under 35 U.S.C. §251."

(B). Rejection of Claims 21 through 41 Under Second Paragraph of 35 U.S.C. §112

The Examiner has implicitly withdrawn all rejections under 35 U.S.C. § 112, in paragraph (6) of the Examiner's Answer.

(C). Rejection of Claims 21 through 60 Under First & Second Paragraphs of 35 U.S.C. §112

The Examiner has implicitly withdrawn all rejections under 35 U.S.C. § 112, in paragraph (6) of the Examiner's Answer.

(D). Rejection Of Claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) Over Nepela

'981

Claims 21, 30 through 32 and 41 differ in language and scope from one another. The final Office action applied Nepela '891 to these claims collectively. Each of these claims is different in its text however, and each defines a different aspect of Appellant's inventions. Accordingly, each of these claims should be considered independently, and grouped separately in consideration of the rejection of these claims under 35 U.S.C. §102(a) as anticipated by Nepela'981.

VIII. ARGUMENT

(IV). Rejection of Claims 21, 30-32 and 41 Under 35 U.S.C. §102(a) Over Nepela '981

The Examiner's Answer has not addressed the issue raised in Appellant's Appeal Brief, and summarily seeks to dismiss Appellant's analysis of the anticipation rejection by stating that "Appellant's references to the siderails (112, 114) are not on point."¹⁰ Instead, the Examiner raises three additional issues which Appellant addresses below. Additionally, Paper No. 28, and its overt withdrawal of "the rejection of claims 21-60 under 35 U.S.C. §251", concomitantly raised issues that were neither addressed in the *Examiner's Answer* nor in Paper No. 28.

A. The Final Rejection Fails To Make A *Prima Facie* Showing Of Anticipation Under 35 U.S.C. §102(a)

Where the applied art fails to disclose all of the elements of the rejected claims, there is no anticipation under 35 U.S.C. §102(a). The Examiner's Answer asserts that:

¹⁰ *Examiner's Answer*, Paper No.20, Page 6, dated 27th of February 2003. ...

“Appellant seems to have ignored cited Fig. 5c of Nepela et al. This figure clearly shows a negative pressure slider with U-shaped air bearing platform (108) which surrounds and defines a negative pressure cavity (area between the legs of the U) with not more than two separate air bearing platforms (the leg portions).”

This excerpt from the Examiner’s Answer seems to refer to centerpad 108 illustrated in Fig. 5C of Nepala ‘981. Nepela ‘981 teaches that “a central negative pressure region 128 that is aft of the centerpad 104 is etched to a nominal depth of about two hundred micro inches below the air bearing surface.”¹¹ Ostensibly, the cross-hatched, unnumbered region aft of “center pad 108” in Figure 5c forms this “central negative pressure region.”¹² Whether the U-shaped region between the two short legs of centerpad 108 in the embodiment illustrated in Fig. 5c of Nepela ‘981 also provides a negative pressure region that is additional to negative pressure region 128 is irrelevant to the question of anticipation because this interpretation of Nepala ‘981 (i) improperly fails to consider the entirety of the rejected claims,¹³ (ii) ignores the express teachings of Nepala ‘981 about the integrity of his design and the cooperative relation between his structural features,¹⁴ and (iii) neglects to consider that while the dimensions, curves and

¹¹ Nepala ‘981, column 6, lines 8-11.

¹² Nepala ‘981, column 6, lines 8-11.

¹³ As noted by *MPEP*, (8th Ed., Rev. 2, May 2004) §2131, “A claim is anticipated only if each and every element in the claim is found, either expressly or inherently described, in a single prior art reference.”

¹⁴ What is unclear from the Final Office action is whether the Examiner’s interpretation of the rejected claims conforms with either the contextualist (see, by way of example, *Housey Pharmaceuticals, Inc. v. Astra-Zeneca Pharmaceuticals LP*, 03-1193 (Fed. Cir. 7 May 2004)) or the literalist (see, for example, *International Rectifier Corporation v. IXYS Corporation*, 02-1414, -1554 (Fed. Cir. 18 March 2004)) approach to claim interpretation.

shapes of the components illustrated by the drawings contained in these patents are large, and may be easily modified arbitrarily with a pencil, the actual devices are minuscule, modification is difficult and the results in performance obtained by each modification is uncertain.¹⁵

1. Nepela '981 Fails To Anticipate Claims 21, 30-32 and 41 Under 35 U.S.C. §102(a)

The Examiner's Answer asserts that:

"Appellant seems to have ignored cited Fig. 5c of Nepela et al. This figure clearly shows a negative pressure slider with U-shaped air bearing platform (108) which surrounds and defines a negative pressure cavity (area between the legs of the U) with not more than two separate air bearing platforms (the leg portions)."¹⁶

This excerpt from the Examiner's Answer seems to refer to centerpad 108 illustrated in Fig. 5C of Nepela '981.¹⁷ The unwritten inference of this excerpt from the *Examiner's Answer* is that the structure illustrated by Figure 5c of Nepela '981 meets Appellant's:

¹⁵ Nepela '981, in an illustrative example of the minuteness of these structural dimensions, states that the (referring to Figure 4a) "central pad 104 has a width 132 of about 20 mils and a length 130 of about 20 mils. The lengths of the portions of the two side rails are about 20 mils for L11, 25 mils for L12, 50 mils for L13, 55 mils for L14 and 60 mils for L15. The width at the leading and trailing edges of the side rails is about 15 mils and the width 118 of the central portion of the side rails is about 8 mils ... central negative pressure region 128 that is aft of the centerpad 104 is etched to a nominal depth of about two hundred micro inches below the air bearing surface." Column 6, lines 1 through 10. At this scale, predictability is uncertain and minute details may not be summarily ignored under, even for purposes of an application of 35 U.S.C. §102(a).

¹⁶ *Examiner's Answer*, Paper No. 20, page 5.

¹⁷ Remarkable by its absence from this excerpt from the *Examiner's Answer*, is the entirety of Appellant's definition of the "U-shaped shaped platform ... , comprising at least one of said not more than two separate air bearing platforms including a side wall portion" set forth in claims 21 and 31.

“a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface and respectively terminating any first rear termination and a second rear termination ... ,”¹⁸

as well as Appellant’s:

“a U-shaped air bearing platform having a plurality of air bearing surfaces surrounding a negative pressure cavity while defining a second plane tangential to said first direction, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending from said lead portion rearwardly toward said rear portion and respectively terminating at a first rear termination and a second rear termination”¹⁹

Nepela ‘981 teaches that “a central negative pressure region 128 that is aft of the centerpad 104 is etched to a nominal depth of about two hundred micro inches below the air bearing surface.”²⁰ Ostensibly, the cross-hatched, unnumbered region aft of “center pad 108” in Figure 5c forms this “central negative pressure region.”²¹ The U-shaped air bearing platform formed by “center pad” 108 region in the embodiment illustrated in Fig. 5c of Nepela ‘981 fails to anticipate those features of claims 21 and 31 which are defined in the rejected claims as,

“a U-shaped air bearing platform ...,”²²

¹⁸ Claim 21, lines 9-13.

¹⁹ Claim 31, lines 7-11.

²⁰ Nepela ‘981, column 6, lines 8-11.

²¹ Nepela ‘981, column 6, lines 8-11.

²² Claim 21, line 9; claim 31, line 7.

comprising,

“at least one of said not more than two separate air bearing platforms including a sidewall portion.”²³

In short, and contrary to the Examiner’s assertion, neither leg of the:

“U-shaped air bearing platform (108) which surrounds and defines a negative pressure cavity (area between the legs of the U) with not more than two separate air bearing platforms (the leg portions)”²⁴

includes “a sidewall portion.”²⁵ Consequently, “each and every element *as set forth in*”²⁶ claims 21 and 31 is not found in Nepela ‘981. The Board is therefore, respectfully urged to refuse to sustain this rejection.

2. The Final Rejection of Claims 21, 30-32 and 41 Under 35 U.S.C. §102(a) As Anticipated By Nepela ‘981 Fails To Consider The Entireties Of Claims 21, 30-32 and 41

The Final Office action asserts that,

“figures 4b, 4c, 5b, 5c and 5d [of] Nepela *et al.* show a slider with a U-shaped platform with a negative pressure cavity (not numbered) behind a cross rail 98 having side wall portions (not numbered) that have an arcuate section and terminate before the rear edge of the slider, and a rear center platform 90 mounting the transducer.”²⁷

²³ Claim 21, lines 12 and 13; claim 31, lines 11 and 12.

²⁴ *Examiner’s Answer*, Paper No. 20, page 5.

²⁵ Claim 21, lines 12 and 13; claim 31, lines 11 and 12.

²⁶ As noted by *MPEP*, (8th Ed., Rev. 2, May 2004) §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), “A claim is anticipated only if each and every element in the claim is found, either expressly or inherently described, in a single prior art reference.”

²⁷ Final Office action (Paper No. 9), mailed on the 9th of October 2002.

The subsequent *Examiner's Answer* responds to Appellant's *Appeal Brief* by dropping the Examiner's earlier assertion that Figures 4b, 4c, 5b and 5d of,

"Nepela *et al.* show a slider with a U-shaped platform with a negative pressure cavity (not numbered) behind a cross rail 98 having side wall portions (not numbered) that have an arcuate section and terminate before the rear edge of the slider, and a rear center platform 90 mounting the transducer",²⁸

and, in support of the final rejection under 35 U.S.C. §102(a), substitutes the assertion that Figure 5c of Nepela '891,

"Appellant seems to have ignored cited Fig. 5c of Nepela *et al.* This figure clearly shows a negative pressure slider with U-shaped air bearing platform (108) which surrounds and defines a negative pressure cavity (area between the legs of the U) with not more than two separate air bearing platforms (the leg portions)."²⁹

This substituted assertion improperly fails to consider the entirety of the rejected claims because neither the Final Rejection nor the *Examiner's Answer* addresses, among other features of the rejected claims, the "side wall portion", a feature of claims 21 and 31 which can not be found in the:

"U-shaped air bearing platform (108) which surrounds and defines a negative pressure cavity (the area between the legs of the U)" of Nepela '981.³⁰

Under 35 U.S.C. §102(a), to make a *prima facie* showing of obviousness, the "elements must be arranged as required by the claim" Nepela '981 states that Figure 5c, as well as Figures

²⁸ Final Office action (Paper No. 9), mailed on the 9th of October 2002.

²⁹ *Examiner's Answer*, Paper No. 20, page 5.

³⁰ *Examiner's Answer*, Paper No. 20, page 5.

5a, 5b and 5d,

“illustrates another embodiment of a negative pressure air bearing slider having two side rails 112, 114”³¹

In essence, these “two side rails 112, 114”³¹ are spaced physically apart and separated by relief vents 133 from the “air bearing platform (108)”³² relied upon by the Examiner to show anticipation.³³ Recognizing the distinctiveness in structure, function and cooperation with other structural components taught by Nepela ‘981 between “the legs of the U”³⁴ and “two side rails 112, 114”, the elements of Nepela ‘981 can not be read as arranged as required by claims 21 and 31; consequently, there is no anticipation.³⁵ The Board is therefore, respectfully urged to refuse to sustain this rejection.

³¹ Nepela ‘981, column 5, lines 40 and 41.

³¹ Nothing in the record before the Board, and certainly not either the *Final Rejection* or the *Examiner’s Answer*, suggests that this rejection under 35 U.S.C. §102(a) rests a difference the nomenclature used by Nepela ‘981 of *side rails 112, 114* and that used by Appellant, of *side wall portion*. As is more fully explained below, Appellant also uses the nomenclature *air bearing surface rails*, and has explained the term, *rails* in column 2, lines 31 through 38.

³² *Examiner’s Answer*, Paper No. 20, page 5.

³³ In the *Examiner’s Answer*, the unwillingness of the Examining Staff to argue that “air bearing platform 108 anticipated Appellant’s “side wall portion” is telling on the issue of anticipation.

³⁴ *Examiner’s Answer*, Paper No. 20, page 5.

³⁵ *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); cited by §2131 of the MPEP, 8th Ed., Rev. 2.

3. The Rejection Of Claims 21, 30-32 and 41 Under 35 U.S.C. §102(a) Depends Upon Misinterpretation Of The Language Of The Claims To Support An Assertion Of Anticipation By Nepela '981

Although the *Examiner's Answer* avoids making an assertion that "the legs of the U" of the "air bearing platform" 108 anticipate Appellant's "side wall portion", the *Examiner's Answer* closes with a statement that,

"Applicant's references to side rails (112, 114) are not on point. These claims do not preclude the presence of other air bearing surfaces in addition to the U-shaped platform. Note also that these claims do not define the size or extent of the negative pressure cavity."³⁶

The *Examiner's Answer* neither elaborates on this statement, nor shows any appreciation for the failure of Figure 5c of Nepela '981 to meet Appellant's:

"a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface and respectively terminating any first rear termination and a second rear termination, at least one of said not more than two separate air bearing platforms including a side wall portion ... ,"³⁷

as well as Appellant's:

"a U-shaped air bearing platform having a plurality of air bearing surfaces surrounding a negative pressure cavity while defining a second plane tangential to said first direction, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending from said lead portion rearwardly toward said rear portion and respectively terminating at a first rear termination and a second rear termination, at least

³⁶ *Examiner's Answer*, Paper No. 20, page 6.

³⁷ Claim 21, lines 9-13.

one of said not more than two separate air bearing platforms including a side wall portion ...”³⁸

Appellant defines the “side wall portions” as defining “third and fourth air bearing surfaces”³⁹

Nepela ‘981 teaches that his,

“negative pressure air bearing slider has two *side rails* providing *air bearing surfaces* extending fully from the leading edge ...”⁴⁰

In other words, Appellant’s “side wall portions” are defined in the same way as the “side rails 112, 114” of Nepela ‘981. Accordingly, the record before the Board does not admit an inference from the Examiner’s statements and assertions, to equate Appellant’s “air bearing platforms ..., at least one ... including a side wall portion” with “the legs of the U” because Nepela ‘981 ascribes this definition to “side rails 112, 114.” This definition may not be arbitrarily ignored in an effort to shoehorn Figure 5c into a more plausible assertion of anticipation, because, as taught by Appellant,

“[d]iffering hydrodynamic forces support the inner and outer air bearing surface (ABS) rails of the slider, and resulting variations in side leakage air flow with skew angle changes can generate roll angle variations. Here, the inner and outer rails refer to those ABS rails of the slider positioned toward the inner periphery and outer periphery of the disc, respectively.”⁴¹

This definition precludes attribution of Applicant’s inner and outer ABS rails to “the legs of the

³⁸ Claim 31, lines 7-12.

³⁹ Column 4, line 26.

⁴⁰ Nepela ‘981, column 2, lines 43-45.

⁴¹ Column 2, lines 31-38.

U” of Nepela ‘891.

B. Modification of Nepela ‘981 in a Manner That Would Render Nepela ‘981 Inoperative, is Impermissible to Support an Anticipation Rejection

In order for an anticipation rejection to be proper under 35 U.S.C. §102(a), the anticipating reference must disclose exactly what is claimed. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. “*Verdegaal Bros. v. Union Oil Co., of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Note here that the Examiner has not relied on “inherency,” accordingly, each and every element must be expressly described in Nepela ‘981.

“There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927F. 2d 1565, 18 USPQ2d 1001, 18USPQ2d 1896 (Fed. Cir. 1991). Where, as in the final Office action, the rejections depend upon a modification of the reference, there is no *prima facie* showing of anticipation under 35 U.S.C. §102(a).

The Examiner’s Answer asserts that:

“Appellant seems to have ignored cited Fig. 5c of Nepela et al. This figure clearly shows a negative pressure slider with U-shaped air bearing platform (108) which surrounds and defines a negative pressure cavity (area between the legs of the U) with not more than two separate air bearing platforms (the leg portions).”

This excerpt from the Examiner's Answer seems to refer to centerpad 108 illustrated in Fig. 5C of Nepala '981. The unwritten inference of this excerpt from the *Examiner's Answer* is that the structure illustrated by Figure 5c of Nepala '981 meets Appellant's:

"a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface and respectively terminating any first rear termination and a second rear termination ... ,"⁴²

as well as Appellant's:

"a U-shaped air bearing platform having a plurality of air bearing surfaces surrounding a negative pressure cavity while defining a second plane tangential to said first direction, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending from said lead portion rearwardly toward said rear portion and respectively terminating at a first rear termination and a second rear termination"⁴³

Nepala '981 teaches that "a central negative pressure region 128 that is aft of the centerpad 104 is etched to a nominal depth of about two hundred micro inches below the air bearing surface."⁴⁴ Ostensibly, the cross-hatched, unnumbered region aft of "center pad 108" in Figure 5c forms this "central negative pressure region."⁴⁵ Whether the U-shaped region between the two short legs of centerpad 108 in the embodiment illustrated in Fig. 5c of Nepala '981 also provides a negative

⁴² Claim 21, lines 9-13.

⁴³ Claim 31, lines 7-11.

⁴⁴ Nepala '981, column 6, lines 8-11.

⁴⁵ Nepala '981, column 6, lines 8-11.

pressure region that is additional to negative pressure region 128 is irrelevant to the question of anticipation because this interpretation of Nepala '981 (i) improperly fails to consider the entirety of the rejected claims,⁴⁶ (ii) ignores the express teachings of Nepala '981 about the integrity of his design and the cooperative relation between his structural features,⁴⁷ and (iii) neglects to consider that while the dimensions, curves and shapes of the components illustrated by the drawings contained in these patents are large, and may be easily modified arbitrarily with a pencil, the actual devices are minuscule, modification is difficult and the results in performance obtained by each modification is uncertain.⁴⁸ The Examiner has ignored that the features of claims 21 and 31 which the Examiner asserts are taught by Fig. 5c of Nepala '981 are defined in the rejected claims as,

⁴⁶ As noted by *MPEP*, (8th Ed., Rev. 2, May 2004) §2131, "A claim is anticipated only if each and every element in the claim is found, either expressly or inherently described, in a single prior art reference."

⁴⁷ What is unclear from the Final Office action is whether the Examiner's interpretation of the rejected claims conforms with either the contextualist (see, by way of example, *Housey Pharmaceuticals, Inc. v. Astra-Zeneca Pharmaceuticals LP*, 03-1193 (Fed. Cir. 7 May 2004)) or the literalist (see, for example, *International Rectifier Corporation v. IXYS Corporation*, 02-1414, -1554 (Fed. Cir. 18 March 2004)) approach to claim interpretation.

⁴⁸ Nepala '981, in an illustrative example of the minuteness of these structural dimensions, states that the (referring to Figure 4a) "central pad 104 has a width 132 of about 20 mils and a length 130 of about 20 mils. The lengths of the portions of the two side rails are about 20 mils for L11, 25 mils for L12, 50 mils for L13, 55 mils for L14 and 60 mils for L15. The width at the leading and trailing edges of the side rails is about 15 mils and the width 118 of the central portion of the side rails is about 8 mils ... central negative pressure region 128 that is aft of the centerpad 104 is etched to a nominal depth of about two hundred micro inches below the air bearing surface." Column 6, lines 1 through 10.

“a U-shaped air bearing platform”⁴⁹

with,

“at least one of said not more than two separate air bearing platforms including a sidewall portion.”⁵⁰

The presence of siderails 112, 114 in Fig. 5c of Nepela ‘981 prevent either of the short legs of centerpad 108 from being read as the “sidewall portion” defined by Appellant’s claims 21 and 31. Moreover, distortion of either leg of centerpad 108 to displace either siderail 112, 114 would destroy the symmetry consistently taught throughout Nepela ‘981. The need for such an impermissible modification of Nepela ‘981 is evidence of record that “each and every element as set forth in the [rejected claims] is [not] found”⁵¹ in the art, and that therefore, Nepela ‘981 fails to convincing evidence of the lack of anticipation of either claim 21 or 31 by Nepela ‘981.

C. The Examiner’s Assertion That *Appellant Specifically Identified Several Structural Features Recited In The Claims To Define Over The Prior Art Rejection Is A Non Sequitur That Does Not Support The Rejection Under 35 U.S.C. §102(a).*

Despite the belated withdrawal of the rejection under 35 U.S.C. §251 the statements made by the Examining staff argue against maintenance of this rejection under 35 U.S.C. §102(a). By way of example, on n page 4 of the Examiner’s Answer, paragraph 11, the Examiner argues that,

“[i]t is the Examiner’s position that, in the parent application, Appellant *specifically identified several structural features recited in the claims to define over the art rejection* made against the

⁴⁹ Claim 21, line 9; claim 31, line 7.

⁵⁰ Claim 21, lines 12 and 13; claim 31, lines 11 and 12.

⁵¹ §2131 *MPEP*, 8th Ed., Rev. 2, May 2004.

originally filed claims in the parent application.” Examiner’s Answer, pages 4 and 5.

The Examiner has distorted the last two paragraphs on page 11 and the first paragraph on page 12 of Appellant’s amendment filed on the 1st of December 1998. The distortion is explained in greater detail in conjunction with the following issue. Additionally, the Examiner has improperly miscast Appellant’s remarks in the amendment of the 1st of December 1998; those remarks were general statements supported by specific examples. Here, the Examiner seeks to mislead the Board by characterizing those remarks as arguments based upon “several structural features recited in the claims to define over the art rejection”, and hides from the attention of the Board that Appellant’s statements on pages 11 and 12 of the amendment of the 1st of December 1998 begin with, include and conclude with four distinct general statements that traverse the anticipation rejection based upon Chapin ‘868:⁵²

- “Claims 1-3, 7, 9-19, and 21-25 are drawn to a negative pressure air bearing slider which includes”
- “Appellant respectfully submits that the claimed slider is not disclosed anywhere in Chapin.”
- “Likewise, none of the numerous other embodiments shown in Chapin disclose a slider according to any of the claims 1-3, 7, 9-19, and 21-25.”
- “Consequently, the difference between the Chapin and the present invention may be analogized to the difference between a river running through a plot of land (Chapin) and a lake with several islands located therein (the present invention).”

All four of these statements are general statements that emphasize the impropriety of the

⁵² Appellant recognizes that all art rejections based upon the Chapin ‘868 reference have been withdrawn in this Appeal.

anticipation rejection and the unsuitability of art such as Chapin '868 to support an anticipation rejection. The Board is invited to observe that the Examiner did not disagree with the technical accuracy of these statements. The Examiner's acquiescence in the correctness of these general statements, which were written in the alternative, is revealed by the Examiner's conduct, namely withdrawal of the anticipation rejection premised upon Chapin '868 in the next office correspondence. In the amendment of the 1st of December 1998, Appellant gave specific examples and did in fact refer to specific structural features of the pending claims to support the general traversal. The Examiner has fixated upon three (3) of those specific structural features, and ignores the fact that those structural features were included among nine (9) different references to structural features, presented either as exemplary features (such as, "which includes") as additional evidentiary distinctions (that is, "also has") or in the alternative (has neither ... "nor does it have") or as a contrast with other features ("likewise, none"). The Examiner incorrectly infers that Appellant argued only specific structural features, and seeks to hide from the Board's attention the fact that Appellant presented general statements and then supported those statements by numerous and alternative references to differences in specific details of the Chapin '868 reference and the rejected claims. This is particularly evident in Appellant's last of the four general statements, where Appellant uses a metaphor of a river and a plot of land, neither of which could reasonably be asserted to be structural features of the pending claims.

In the sole instance in which Appellant, in the amendment of the 1st of December 1998 asserted that a structural feature "clearly distinguishes", the references are to the "two trailing

platforms, 110c and 110d.” Although both of these elements are present in these rejected claims 21 and 31, the Examiner has not mentioned this statement even though the statement is present in the second of the three paragraphs on pages 11 and 12 cited by the Examiner. Accordingly, the Examiner’s attempt to recast Appellant’s general explanation of the impropriety of the anticipation rejection as a specific argument by Appellant, is improper, ignores the Examiner’s subsequent conduct in withdrawing the rejection without amendment of any of the claims to include those specific examples supporting Appellant’s general statements, and fails to respond to the remarks of Appellant in pages 11 and 12 of the Amendment on the 1st of December 1998.

The *non sequitur*⁵³ is best demonstrated by the fact that if any of the nine (9) features set forth on pages 11 and 12 of Appellant’s 1st of December amendment were not present in the patent claims on an objective application of 35 U.S.C. §102(a), those claims would still remain patentably distinguishable over Chapin ‘868 by the presence of any of the remaining eight (8) structural features mentioned in those paragraphs. In summary, the three paragraphs set forth on pages 11 and 12 of the 1st of December amendment simply direct the Examiner’s attention to the language of the claims and politely requested the Examiner to read those claims while examining the drawings of Chapin ‘868 and emphasized the speciousness of the anticipation rejection by pointing to nine (9) different structural distinctions, any of which support patentability. The subsequent statements by the Examining staff is arguing to maintain the now

⁵³ Technically, this argument in the Examiner’s Answer is technically referred to as an *ignoratio elenchi*, that is, a logical fallacy which consists in apparently refuting an opponent while actually disproving some statement different from that advanced by him (OED).

withdrawn recapture rejection however, when considered beside the Examining staff's admission of the novelty of Appellant's air bearing surface configuration now claimed.

E. Whether Claims 21 and 31 do, or do not Preclude the Presence of Other Air Bearing Surfaces in Addition to the U-Shaped Platform is Irrelevant to Determinations of Anticipation Under 35 U.S.C. §102(a).

The Examiner now argues that rejected claims 21 and 31 "do not preclude the presence of other air bearing surfaces in addition to the U-shaped platform. Note also that these claims do not define the size or extent of the negative pressure cavity. The slider shown in Fig. 5c has ALL of the structural features recited by these claims." As was demonstrated in the discussion of the foregoing issue, Fig. 5c of Nepela '981 cannot be read to meet both Appellant's U-shaped air bearing platform comprising not more than two separate air bearing platforms, each extending rearwardly" and "at least one of said not more than two separate air bearing platforms including a sidewall portion." In short, the Examiner's assertion that claims 21 and 31 "do not preclude the presence of other air bearing surfaces" is a misleading and confusing argument. The feature attacked by the Examiner is only Appellant's "U-shaped air bearing platform", which defines specific air bearing surfaces, and does not purport to either define or exclude other air bearing surfaces upon the principal surface. What Nepela '981 lacks is this specific U-shaped air bearing platform. The ability of claims 21 and 31 to read upon other sliders which have air bearing platforms located at other parts of the principal surface is irrelevant to the question of whether centerpad 108 anticipates Appellant's U-shaped air bearing platform, as defined by claims 21 and 31. The Examiner has incorrectly considered only isolated limitations in

Appellant's definition, and has failed to consider Appellant's definition of the U-shaped air bearing platform in its entirety. In view of the inability of Nepela '981 to meet the entirety of these features of Appellant's U-shaped air bearing platform, there is no anticipation.

IX. CONCLUSION

The Examiner Staff has overlooked the express teachings of Nepela '981⁵⁴ which conclusively prevent "the leg portions"⁵⁵ of centerpad 108 from being read upon Appellant's U-shaped air bearing platforms defined by claims 21 and 31. Given this express teaching by Nepela '981, and its consistency with Appellant's definition of *air bearing surface rails*, the interpretation given to center pad 108 by the Examining Staff is technically at variance with Nepela '981, and that interpretation may not be used to support an assertion of anticipation under 35 U.S.C. §102(a). The Board is respectfully requested to refuse to sustain this rejection.

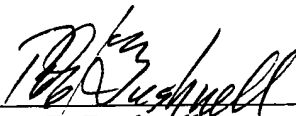
⁵⁴ See, by way of example, the teachings of Nepela '981 in column 2, lines 44 through 46, which not only recognize that its "two side rails" are distinct and functionally different from the other air bearing surfaces, but attribute specific critical properties and functions to those "two side rails."

⁵⁵ *Examiner's Answer*, Paper No. 20, page 5.

This brief is filed in triplicate.

A Request for Oral Hearing is simultaneously submitted herewith. The statutory fee incurred was previously paid on the 28th of April 2003. Should other fees be incurred however, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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